IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1953

NO. 424

WESTINGHOUSE ELECTRIC CORPORATION,
a corporation,
Petitioner,

v.

BULLDOG ELECTRIC PRODUCTS COMPANY,
a corporation,
Respondent.

REPLY BRIEF FOR PETITIONER ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT

Only a very short reply to the Respondent's brief is deemed necessary.

Respondent states on page 2 of its brief that the decisions below "are based essentially upon determination of questions of fact." This ignores the direct statement in the concurring opinion of Mr. Justice Douglas (apparently speaking for the Court in this regard) in *A. & P. Tea Co. v. Supermarket Co.*, 340 U. S. 147, 155-6, that "the question of validity of a patent is a question of law."

In regard to commercial use of the inventions of the three patents here involved, Respondent states, on page 3 of its brief, that no commercial use has been made "c

the circuit breaker constructions shown in the drawings and described in the specifications" of these patents. A similar assertion is also made at pages 14 and 15 but Respondent does not refute our statement, which is fully supported by the record (R. 168 and 169 and elsewhere), that the claims of the Hodgkins and Swingle patents cover the "Multi-breaker" and those of the Jennings patent cover the "Quicklag" breaker, both of which devices have admittedly had extensive commercial use. As stated, for example, in the often-quoted case of *Smith* v. *Snow,* 294 U. S. 1, 11, a patentee is not confined to the illustrative embodiment of an invention shown in his drawings and described in his specifications "since the claims of the patent, not its specifications, measure the invention."

Respondent asserts on page 8 of its brief that the record in the case at bar does not disclose that the judgment in the case of *Westinghouse Electric & Mfg. Co.* v. *Frank Adam Electric Co.,* (C. A. Opinion, 146 F. 2d 165) "was ever reinstated" or "what claims of either the Hodgkins patent or the Jennings patent were found valid or infringed by the District Court in Missouri." It is submitted that it is immaterial whether or not the judgment was ever formally reinstated, since it was never reversed and the defendant took a license because of it. As to the claims, the Eighth Circuit Court of Appeals said (p. 166) that "After trial upon the merits the court [below] found and decreed that all of the patents in suit are valid as to all the claims sued upon; that Hodgkins 2,073,103 has been infringed as to all claims sued upon * * *". The claims there in suit were specifically set out in the decree, which is a matter of court record, and, as to the two patents referred to, include claims that were held invalid by the Court of Appeals for the Fourth Circuit in the instant case.

The case in the Eighth Circuit Court of Appeals was fully briefed and argued on the merits, as appears from the opinion (p. 166), and, as pointed out in the petition, there would have been no occasion or necessity to remand the case for a trial on the unclean hands issue if the Court had been of the opinion that the patents involved were invalid over the prior art. As stated in the petition, the logical inference from the action taken by the Court of Appeals is that it, in effect, confirmed the findings of the District Court on validity, as otherwise it would presumably have disposed of the case on that issue, as it did in the case of *Koochook* v. *Barrett*, 158 F. 2d 463 (cited in the petition), instead of putting the parties to the trouble and expense of supplemental proceedings on the unclean hands question that would have been wholly unnecessary if the patents had been found to be invalid. The present case thus presents a genuine conflict between the two Circuits as asserted in the petition.

The case referred to on page 9 of Respondent's brief, namely, *Frank Adam Electric Co.* v. *Colt's Patent Fire Arms Mfg. Co.*, 148 F. 2d 497, involved some detail patents of the Colt's Co. and the statement (to the effect that the circuit breaker art was crowded) referred to in the brief was made in a report of a special master holding one of such patents valid and infringed, which report was sustained by the District Court in a decree that was reversed by the Court of Appeals. Clearly the master's comment is neither pertinent nor competent here.

Respondent's brief makes repeated references (as at pages 2, 12 and 14) to the fact that the courts below "concurred" in their findings but that is immaterial here since there is a conflict in findings and conclusions between the courts in the Eighth and Fourth Circuits which should be

resolved by this Court. *Sanitary Refrigerator Co.* v. *Winters et al.*, 280 U. S. 30, 36; *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, 180; and *Thomson Co.* v. *Ford Motor Co.*, 265 U. S. 445, 447.

It of course will be understood that the fact that various statements made in the Respondent's brief, having to do with the merits of the issues of validity and infringement that will be in issue if the petition is granted, are not answered in this reply brief does not mean that Petitioner acquiesces therein or agrees as to their accuracy.

It is submitted that adequate grounds for allowance of the writ have been shown in the petition and have not been successfully refuted in the Respondent's brief.

Respectfully submitted,

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November 27, 1953